

No. 18-109

IN THE
Supreme Court of the United States

ARIOSA DIAGNOSTICS, INC.,
Petitioner,

v.

ILLUMINA, INC.,
Respondent.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether, under the version of the Patent Act that preceded the enactment of the America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), a published patent application may be given the priority date of an earlier-filed provisional application for prior art purposes, if the later, published application does not claim as the invention the matter supposedly disclosed in the earlier-filed provisional.

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, respondent Illumina, Inc. states that Illumina, Inc. has no parent corporation. No publicly held company owns ten percent or more of Illumina, Inc.'s stock.

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INTRODUCTION

Ariosa’s petition presents an exceedingly narrow question of rapidly diminishing importance. Under the Patent Act, a patent can be invalid if it is obvious in light of, or anticipated by, the “prior art.” The petition asks when, under the pre-AIA version of the Patent Act, the disclosures in a filed patent application will be afforded the earlier date of a non-public, informal provisional application for purposes of determining whether those disclosures are “prior art.” The Patent Act requires applicants to file the full application within one year of filing of the provisional. As a result, the question matters only in the relatively infrequent situations where that one-year window is the difference between the allegedly invalidating disclosure coming before, and coming after, the priority date of the patent at issue.

More important, the petition raises the issue under a now-superseded version of the statute. This case is governed by the version of the Patent Act existing in 2006. But the America Invents Act of 2011 substantially overhauled the relevant statutory provisions—35 U.S.C. § 102(e) with § 119(e)(1), § 111(b), § 112, and § 122(b). Indeed, the AIA established a specific provision, now found in § 102, to specifically address this issue; it created a potentially relevant definitional distinction between the “invention” and the “claimed invention” not found in prior law; and it has its own legislative history (to the extent that matters).

The petition does not even purport to involve patent law as it exists now. See Pet. 5 (“Unless otherwise noted, all references to Title 35 in this petition are to the version in effect prior to the passage of the America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).”). The required statutory appendix does not include the current version

of the statute. See Pet. App. 23a-28a (all 2006 versions). The number of patents raising the question presented under that now superseded version of the statute is small and rapidly diminishing.

Seeking to create the illusion of importance, Ariosa presents the Federal Circuit's construction of the prior statute as disobedience. The interpretation, petitioner asserts, conflicts with *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), a case that predates the 1952 Patent Act by 26 years. According to Ariosa, *Milburn* stands for the "important principle" that only the first inventor is entitled to the patent. Pet. 18. As a result, Ariosa declares, *Milburn* holds that any prior patent application is prior art as of the date it was filed so long as it is not abandoned. *Ibid.* Ariosa overlooks the fact that Congress specifies, in the detailed and reticulated provisions of the Patent Act, when and how particular disclosures and events qualify as prior art. Congress has adjusted that legislative scheme in significant ways. For example, the informal, non-public provisional applications at the heart of the petition here were created by Congress only *in 1994*, almost 70 years after this Court decided *Milburn*. The statutes regulating the role of such non-public applications in the prior-art analysis have changed over time—and were modified again in 2011. *Milburn* is not constitutional law that overrides Congress's revision to the detailed scheme for patent priority for different species of patent applications. It interpreted now-antiquated statutes that have long been superseded.

Besides, Ariosa over-reads *Milburn*. Numerous categories of prior art do not strictly follow a first-to-invent rule. Ariosa relies on the crutch of its broad-brush reading of *Milburn* because its statutory interpretation

is wrong. The Patent Office and the Federal Circuit correctly understood those interlocking statutory provisions and properly rejected Ariosa’s Patent Office challenge. The petition should be denied.

STATEMENT OF THE CASE

I. STATUTORY BACKGROUND

A. The Pre-AIA Statutes

The Patent Act sets forth the basic requirements for granting a patent. Section 102 of the version at issue here provided that “[a] person shall be entitled to a patent unless,” for example, “the invention was described in * * * an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” 35 U.S.C. § 102(e) (2006). That disqualification, based on prior description in a printed publication, has existed in the Patent Act for decades.

In 1994, Congress added a new form of patent application, the “provisional” application. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 154, 108 Stat. 4809, 4986-4987 (1994) (codified as amended at 35 U.S.C. § 111). Because they are relatively informal, Congress has restricted their use. For example, they cannot be published under pre-AIA § 122. They will never issue as patents as specified in 37 C.F.R. § 1.53(i). They lapse one year from filing in accordance with pre-AIA § 111(b)(5), and thereafter cannot establish the “priority date” of the invention (the date of invention so to speak).

When Congress established provisional applications, it did not include them among the categories of patent filings that count as prior art. Under § 102(e), only “an application for patent, *published under section 122(b)*” is prior art. Pre-AIA 35 U.S.C. § 102(e) (2006) (emphasis

added). Provisional applications were not published under §122(b). See Pre-AIA 35 U.S.C. §122(b) (2006) (“An application shall not be published if that application is * * * a provisional application filed under section 111(b) * * * .”).

But a provisional application could still affect the prior-art analysis. While provisional applications are not prior art under old §102(e), published non-provisional applications are prior art. And, under §119(e)(1), the Patent Office and courts are to treat a later-filed, published patent application as if it were filed on the date of the provisional, if certain conditions are met. See Pre-AIA 35 U.S.C. §119(e)(1) (2006). In particular:

“An application for patent filed under section 111(a) * * * for *an invention* disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title * * * shall have the same effect, *as to such invention*, as though filed on the date of the provisional application * * * .

Ibid. (emphasis added). Another section of the statute, pre-AIA 35 U.S.C. §100 (2006), defined “invention” to mean “invention or discovery.” As a result, where a published application was filed within one year of a provisional, §119(e)(1) allowed it to be treated as filed on the date of the earlier-filed, provisional patent application where statutory requirements are met.

B. The Post-AIA Statutes

In 2011, Congress substantially revised certain provisions of the Patent Act, including the definition of prior art in §102. New 35 U.S.C. §102(a)(2) largely replaces prior §102(e). Prior §102(e) disqualified the invention from patent eligibility if “the *invention* was described in

– (1) an application for patent, published under section 122(b), by another filed in the United States before the *invention* by the applicant for patent * * *.” By contrast, new, post-AIA 35 U.S.C. §102(a)(2), provides that the patent shall not be granted if the “*claimed invention* was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b),” that “was *effectively filed* before the effective filing date of the *claimed invention*.” The AIA defines the newly introduced term, “claimed invention,” as meaning “the subject matter *defined by a claim* in a patent or an application for a patent.” Post-AIA 35 U.S.C. §100(j) (emphasis added).

The AIA also created a new subsection of §102—§102(d)—to specifically address the priority date of patent applications when invoked “as Prior Art”:

For purposes of determining whether a patent *or application for patent* is prior art to a *claimed invention* under subsection (a)(2), such patent *or application* shall be considered to have been effectively filed, *with respect to any subject matter described in the patent or application—*

* * *

(2) if *the patent or application for patent is entitled to claim a right of priority* under section 119 * * * based upon 1 or more prior filed applications for patent, *as of the filing date of the earliest such application that describes the subject matter.*

Post-AIA 35 U.S.C. §102(d) (emphasis added).

New §102(d) thus provides a specific rule for patent applications. First, a patent application can be considered to be prior art to a claimed invention. Post-AIA 35 U.S.C. §102(d). Second, “the application” is treated as

effectively filed, “with respect to any subject matter described,” on “the filing date of the earliest such application that describes the subject matter” whenever the application is entitled to claim a right of priority under § 119. *Ibid.*

Section 119 remains largely unchanged. It continues to treat applications “as though filed on the date of the provisional application” when the “invention” of the application is described in the provisional. Post-AIA 35 U.S.C. § 119(e)(1).

II. PROCEEDINGS BELOW

A. The Patent Office’s Decision

This case concerns a patent—U.S. Patent No. 7,955,794 (the “794 Patent”)—that was previously upheld in U.S. district court following a full trial. *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, No. 12-cv-05501-SI (N.D. Cal. Jan. 25, 2018), ECF 633. In addition to losing its invalidity arguments there, Ariosa has brought four different failed Patent Office challenges against that patent. *Ex parte* Reexamination No. 90/013,666; *Ex parte* Reexamination No. 90/013,667; *Ex parte* Reexamination No. 90/013,671; *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2015-01091 (P.T.A.B. Oct. 30, 2015).

This petition is part of that persistent multi-year litigation effort to challenge Illumina’s patent. It stems from one of Ariosa’s five Patent Office challenges, an Inter Partes Review (“IPR”) proceeding Ariosa initiated before the Patent Office. The IPR proceeding was instituted to address only Ariosa’s challenge based on the Fan Reference, U.S. Published Application 2002/0172946. Ariosa argued the Fan Reference qualifies as “prior art” under pre-AIA law, and discloses the exact same inven-

tions as the claims of the '794 Patent, thus “anticipating” Illumina’s inventions.

The Patent Office’s Trial and Appeal Board (“PTAB”) rejected that theory. Pet. App. 19a. During the Patent Office proceedings, Illumina established that the Fan Reference is not prior art, and thus cannot invalidate the '794 Patent, because it was published *after* the '794 filing date. It was undisputed that the '794 Patent was entitled to a September 2000 effective date. *Id.* at 16a-17a. Fan was filed on February 7, 2001. *Id.* at 8a.

Ariosa argued that, under § 102(e), Fan is entitled to priority to a provisional application, U.S. Provisional 60/180,810 (the “'810 provisional application”). The '810 provisional application is a totally different document compared to the Fan Reference: It consists of a stapled-together grant application and corporate invention disclosure. C.A. App. 1460-1509. Illumina established that the '810 provisional application does not support the Fan Reference, because the documents do not resemble each other and the Fan Reference does not disclose the inventions of the '794 Patent in any event. Pet. App. 17a; see C.A. App. 377-393 (Illumina Response in P.T.A.B.).

Although Ariosa’s petition is focused on whether the Fan Reference can qualify as prior art under § 102(e) of pre-AIA law, Ariosa’s anticipation argument based on the Fan Reference was weak at best. Its own expert, Professor Fu, flatly admitted that the Fan Reference does *not* anticipate the '794 Patent:

Q: And you’ll agree that the '946 application [the Fan Reference] does not teach every element of any of the '794 claims properly because of the problem that you identified, correct?

A: Yes.

Q: You'll agree with that, won't you?

A: Right.

C.A. App. 3283:24-3284:7 (objection omitted). Professor Fu's fundamental admission is significant: He is an inventor of the Fan Reference. Anticipation by Fan was Ariosa's only theory at the IPR trial.

Professor Fu's admission is unsurprising. As noted, the '810 provisional application, which supposedly provides an early enough priority date to support the Fan Reference's disclosure, is actually a stapled together invention disclosure form and grant application that does not resemble the Fan Reference.¹

The PTAB issued its Final Written Decision in the IPR on January 7, 2016. In an 18-page opinion, the PTAB denied the IPR Petition in its entirety, upholding the validity of the '794 Patent. Pet. App. 3a-20a. The PTAB concluded that Ariosa had failed to establish that the Fan Reference was "prior art" under the Federal Circuit's decision in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). *Dynamic Drinkware* confirmed that, under pre-AIA §102(e)(1) and §119(e)(1), priority is measured by reference to the claimed invention.

¹ The amicus brief of anti-intellectual property advocacy group Electronic Frontier Foundation ("EFF") states that there "is no dispute that this preexisting knowledge would invalidate Illumina's patent if it appeared in the applicant's claims—the part of the application specifying the boundaries of the applicant's legal rights—as well as the part describing the nature and operation of the applicant's work." EFF Amicus Br. 3. EFF cites nothing to support that statement, and it is flatly contrary to Professor Fu's admission and the truth. There is no reason to believe EFF knows anything about the technological particulars of the parties' dispute.

In essence, Ariosa had argued that, under pre-AIA law, *Dynamic Drinkware*'s prior-art requirements apply when determining when an issued patent should be afforded an earlier priority date, but not when making the same determination for a published patent application. The PTAB rejected that position. *Dynamic Drinkware* was grounded on an interpretation of pre-AIA §102(e)(1) and §119(e)(1) that does not distinguish between issued patents and published patent applications. Pet. App. 19a (“Petitioner has provided no persuasive authority demonstrating that 35 U.S.C. §119(e)(1) applies only to issued patents, and not published patent applications.”).

On September 29, 2016, the PTAB denied Ariosa's request for reconsideration. C.A. App. 37-53. Ariosa had argued, again, that *Dynamic Drinkware* does not apply to published patent applications, and that Ariosa was not given a fair chance to meet that test regardless. *Id.* at 38. The PTAB again explained that Ariosa had failed to establish that *Dynamic Drinkware* was inapplicable to published patent applications under pre-AIA law. *Id.* at 42 (“Notably, Petitioner in its Request for Rehearing again does not provide any persuasive authority in support of its position that 35 U.S.C. §119(e)(1) applies only to issued patents, and not published patent applications.”). The PTAB further ruled that Ariosa's belated attempt to meet the *Dynamic Drinkware* test failed and its lack of notice argument was unpersuasive. *Id.* at 43-50.

B. The Federal Circuit's Decision

On appeal, Ariosa challenged the PTAB's application of *Dynamic Drinkware* to this case under pre-AIA law. On December 11, 2017, in a non-precedential decision, the panel unanimously rejected Ariosa's arguments, sum-

marily holding that the PTAB did not err. Pet. App. 1a-2a.

Ariosa filed a rehearing petition, reiterating the positions it pressed before the panel. Pet. Reh'g in *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. 2016-2388 (Fed. Cir. Feb. 9, 2018), ECF 88. In its opposition, Illumina explained, among other things, that the non-precedential, summary decision did not deserve en banc treatment and that the case was properly decided under pre-AIA law. The Federal Circuit denied the rehearing petition. Pet. App. 22a.

C. Ariosa Is Found To Infringe the '794 Patent and Its Invalidity Defenses Are Rejected

In the meantime, on January 25, 2018, the jury reached a verdict in Illumina's infringement suit against Ariosa in district court. The jury found that Ariosa infringed the '794 Patent and rejected all of Ariosa's invalidity defenses, including its prior-art arguments. No. 12-cv-05501-SI, ECF 633. Ariosa did not preserve any arguments based on the Fan Reference, even though the district court's case management order permitted Ariosa to argue obviousness. It abandoned that argument on the way to trial.

REASONS FOR DENYING THE PETITION

The petition raises an issue of limited and rapidly diminishing importance—the proper construction of a statutory provision that was superseded years ago. Petitioner does not seek review of the proper construction of current law. It seeks review of the Federal Circuit's construction of pre-AIA law. But the pre-AIA version of the statute at the heart of this case does not apply to any application filed after the AIA's effective date. America Invents Act, Pub. L. No. 112-29, 125 Stat.

284, 288 (2011). With each passing day, there are fewer and fewer patents to which any decision in this case would apply. The issue petitioner presses, moreover, has relatively infrequent application. There is no reason for this Court to grant review to decide the meaning of a superseded issue of limited—and diminishing—importance in any event.

I. THE QUESTION PRESENTED IS OF LIMITED AND RAPIDLY VANISHING IMPORTANCE

A. This Case Concerns the Proper Construction of Superseded Statutory Provisions

The petition does not assert that the petition presents the proper interpretation of current law. It instead asks this Court to interpret pre-AIA § 102(e), and what counts as “prior art” under that former provision, to argue about when the filing date of an earlier, informal provisional application can be used as the priority date for later non-provisional applications—even if the non-provisional applications are very different documents that do not support the claimed inventions.

But pre-AIA § 102(e) is no longer good law. In the AIA, Congress substantially revised and restructured § 102, which defines what constitutes “prior art” in concert with other provisions of the Patent Act. The AIA, in particular, rewrote the provisions regarding the role of patents and applications as prior art, splitting those out between current § 102(a)(2) and (d). It added a new statutory definition related to those new provisions. It made a host of other changes. And there is (to the extent it matters) legislative history associated with those changes to the Patent Act. *Ariosa* does not analyze how the current statute relates to the old law on which it seeks review. It cites no court that has done so. It

simply seeks review of a superseded version of the statute.

The petition makes that—and the absence of forward-looking significance—clear. Consistent with this Court’s Rule 14(1)(f), Ariosa enumerates the statutes “involved.” Ariosa includes only statutes “in effect prior to the passage of the America Invents Act.” Pet. 5. Its statutory appendix includes only the 2006 version of the Patent Act. Pet. App. 23a-28a. The post-AIA version is absent. Ariosa’s selection of only superseded statutes for the petition confirms what the rest of the petition makes clear: Ariosa seeks this Court’s review of a decision that is based on superseded statutory provisions with limited and declining future effect. There is no point to this Court granting review here, to decide the meaning of a prior version of the law, particularly where the analysis under the current version may be entirely different.

The differences are potentially significant. Pre-AIA § 102 lacked any provision to expressly address when a patent can be given an earlier provisional application’s priority date for “prior art” purposes. As a result, courts invoked § 119, which generally addresses the priority date that is accorded to *inventions*. Thus, before the AIA, courts read § 119(e)(1) as requiring them to determine whether a provisional application properly discloses the “invention” pursuant to § 112(a), such that the provisional application can receive the earlier priority date “as to such invention.” See Pre-AIA 35 U.S.C. § 119(e)(1) (2006). The question of priority dates thus was examined with respect to disclosure of “the invention,” which the Federal Circuit read to mean “the subject matter being *claimed* by the applicant.” *In re Wertheim*, 646 F.2d 527, 535 (C.C.P.A. 1981) (emphasis added).

The Post-AIA version of § 102, however, incorporates a new provision that specifically addresses when provisional applications can constitute invalidating “prior art.” It specifies that, “[f]or purposes of determining whether *a patent or application* for patent is prior art to a claimed invention under subsection (a)(2), *such patent or application* shall be considered to have been effectively filed, with respect to *any subject matter described* in the patent or application” on “the earliest such application that describes the subject matter,” if the “patent or application for patent is entitled to claim a right of priority under section 119 * * * based upon 1 or more prior filed applications for patent.” Post-AIA 35 U.S.C. § 102(d) (emphasis added). That language specifies that an otherwise qualifying application shall be treated as prior art on “*any subject matter described* in the patent or application.” It does not appear to limit applying the earlier priority date to the invention the application claims. New § 102(d)—which addresses “described” subject matter—has no parallel in pre-AIA § 102.

The AIA, moreover, added a salient, newly defined term to § 102. Ariosa’s argument is, in essence, that an unpublished provisional application can be prior art for any invention that is allegedly disclosed but not claimed. Pet. 2. While the pre-AIA version of the statute generally used the word “invention,” the AIA added a newly defined term—“claimed invention”—which is different from “invention.” The term “claimed invention” is defined to mean “the subject matter *defined by a claim* in a patent or an application for a patent.” Post-AIA 35 U.S.C. § 100(j) (emphasis added). That term is used in new § 102, which states that the patent shall not issue if the “*claimed invention*” was previously described in the prior art. Post-AIA 35 U.S.C. § 102(a). But § 119 contin-

ues to provide that the filing date of a patent can relate back to an earlier filing if it adequately describes “the invention.” That disparate use of “claimed invention” in §102, and just “invention” in §119, may suggest a difference in meaning not previously present. Likewise, the prior version of the Patent Act lacked new §102(d)(2), which affords any art “the earliest such application that describes *the subject matter*.” Post-AIA 35 U.S.C. §102(d) (emphasis added). Finally, to better understand the import and meaning of those and other relevant changes, some members of the Court might wish to consult the legislative history of the AIA—which, according to *Ariosa*, suggests a possible intent to overrule Federal Circuit precedent. See Pet. 27 (quoting 157 Cong. Rec. 3422 (2011) (statement of Sen. Kyl)).

Ariosa addresses those changes not at all. It does not ask this Court to decide the proper construction of the statute as it currently exists. Nor could it: This case is governed by the *pre-AIA* version. *Ariosa*, moreover, cites no cases addressing the proper interpretation of the current version of the statute, making this Court’s consideration of the issue hopelessly premature. “[T]his is a court of final review and not first view.” *Adarand Constructors, Inc. v. Mineta*, 534 U.S. 103, 110 (2001) (per curiam). The sole issue *Ariosa* does raise is the construction of an outdated version of the statute—a version of little forward-looking and rapidly diminishing importance. Review is unwarranted.

B. The Existence of Pre-AIA Patents Does Not Justify This Court’s Review

Perhaps recognizing that this case presents no question regarding the meaning of the current statute, *Ariosa* contends that, “regardless of whether the Federal Circuit’s rule applies to post-AIA patents,” its decision

would affect a substantial category of older patents. Pet. 31. But the issue is narrow to begin with. For pre-AIA cases, the issue arises only where the claim of invalidity rests on a patent that post-dates the invention, but allegedly should be given the earlier date of an unpublished provisional application. The pre-AIA statute, moreover, denies unpublished provisional applications any effect unless the non-provisional application is filed within a year. As a result, the issue can affect the outcome only if the patent-in-suit has a priority date that falls in the one-year window *between* the provisional application date and the date of the application identified as prior art.

Ariosa purports to identify *six* instances involving pre-AIA patents in which an original patent examination, or a Patent Office reconsideration of a patent, involved this issue. Pet. 28. But even those examples overstate how often the issue arises. Four of the six instances did not even turn on the issue raised by the petition.

For example, in *Ex Parte Lee*, 2017 WL 1101681 (P.T.A.B. Mar. 16, 2017), cited Pet. 28, the Board found that the provisional application wholly failed to support the portions of the published application that allegedly constituted invalidating prior art. The claim-based priority analysis at the heart of Ariosa's challenges had no bearing on the outcome. *Ex Parte Lee*, 2017 WL 1101681, at *6 (“[T]he Examiner does not show that Davies’ provisional application supports the relied-upon subject matter in the rejection under 35 U.S.C. §112, first paragraph, let alone *also* show that Davies’ provisional supports the *claimed* subject matter of Davies’ published utility application.”).

In *Ex Parte Budagavi*, 2018 WL 1621817 (P.T.A.B. Mar. 22, 2018), the Board reversed a rejection because

the Examiner improperly “presumed” that the provisional application supported the relied-upon disclosure of the patent that was allegedly invalidating. That was error because no such presumption exists. *Id.* at *3 (“We do not presume that paragraphs 5 and 78 of Van Der Auwera find support in paragraphs 2 through 4 of the ’046 provisional and paragraphs 5 through 7 of the ’173 provisional, for we have no basis on this record for doing so.”). A claim-based priority analysis was not at issue at all.

In *Ex parte Bullock*, 2017 WL 657375, at *3 (P.T.A.B. Jan. 31, 2017) and *Ex parte Mann*, 2016 WL 7487271, at *4 (P.T.A.B. Dec. 21, 2016), the examiners erred by failing to apply the proper priority analysis at all. There is no basis for concluding that the outcome of those examinations would have changed if Ariosa’s view of pre-AIA law were adopted. The examiners simply did not reach the issue. Given the number of patent applications filed each month, it is unsurprising that a couple of examiners (who are normally not attorneys) failed to apply the governing legal framework.²

C. *Milburn* Is Irrelevant to This Case and Does Not Make the Petition Important

Ariosa attempts to make this about consistency with this Court’s 1926 decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926). The Court, Ariosa urges, should grant review to “bring the Federal

² Notwithstanding amici’s desire to narrow patent rights—evident from their past writings—their briefs read as if the petition were directed to current law. Ariosa acknowledges that the decision below and its petition are confined to pre-AIA law. Yet the amici briefs are written as though prior § 102(e) still exists and that this case is about the current law.

Circuit back in line with the principles this Court has articulated.” Pet. 21. No such concerns are raised.

The meaning of “prior art”—and the complex system for determining when a later patent can be assigned an earlier date—are questions of statutory construction in the first instance. *Milburn* thus is not a constitutional decision that can nullify an otherwise detailed statutory scheme. It was based on a few then-existing patent statutes. The 1952 Act created a comprehensive statutory framework for patent law that, among many other things, defines what is prior art. Some provisions of the 1952 Act may have been intended to codify *Milburn*’s general principles, but the Act’s detailed provisions go well beyond, and provide more guidance than, *Milburn*’s general statements.

Indeed, in 1926, neither published patent applications nor informal provisional applications existed. The *Milburn* Court could not have foreseen the issues raised by these new statutory creatures. Provisional applications were created in 1994, and are addressed in detail in pre-AIA § 111. The modern concept of published applications was created in 1999. It was governed by pre-AIA § 111. It allowed (but did not require) pending patent applications to publish even if they never issue as patents. The notion that *Milburn* created a comprehensive scheme for determining when these yet-to-be created (or even conceived of) documents become prior art is rather far-fetched. The issue is governed in the first instance by the statute, which Congress regularly revises, updates, and harmonizes.³

³ See, e.g., *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 966 (2017) (rejecting contention that

Regardless, neither the 1952 Act nor any subsequent enactment codifies the “first to invent” rule that Ariosa ascribes to *Milburn*. Pet. 7. The law is full of examples of where there might be an earlier invention that, in fact, does *not* preclude the issuance of a patent to a later inventor. Non-public inventions have never been invalidating. *Woodland Tr. v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998). Other examples of non-invalidating “prior inventions” under pre-AIA law include: (1) published patent applications that are commonly owned but not identical,⁴ (2) a delayed reduction to practice,⁵ (3) certain foreign sales,⁶ (4) an abandoned or rejected patent application duly filed at the Patent Office,⁷ (5) international patent applications without designations of the United States as required by law,⁸ (6) public experimental uses,⁹ (7) an uncorroborated disclosure of an invention,¹⁰ and (8) a reference that is

Congress incorporated pre-1952 precedent about laches into the Patent Act); *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1361 (Fed. Cir. 2015) (“[T]his paragraph of the 1952 Act overruled the *Halliburton* case”); *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1096 (Fed. Cir. 1987) (“Although in making these changes [in 1952] Congress did not specifically state that it intended to abrogate *Maytag*, that was the necessary effect of what Congress did.”).

⁴ See Pre-AIA 35 U.S.C. § 103(c)(1) (2006).

⁵ See, e.g., *Lutzker v. Plet*, 843 F.2d 1364 (Fed. Cir. 1988).

⁶ See Pre-AIA 35 U.S.C. § 102(b) (2006).

⁷ See, e.g., *In re Lund*, 376 F.2d 982 (C.C.P.A. 1967).

⁸ See Pre-AIA 35 U.S.C. § 102(e)(2) (2006); see also 37 C.F.R. § 1.55.

⁹ See, e.g., *Grain Processing Corp. v. Am. Maize-Products Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988).

¹⁰ See, e.g., *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157 (Fed. Cir. 2006).

deemed too inaccessible or poorly indexed even though available to the public.¹¹

Provisional applications do not necessarily publish at all. In that sense, they are akin to secret prior art that springs only after-the-fact. If disclosed, such applications are often disclosed only years later. Congress has set forth by statute what it considers the appropriate policy balance for enhancing the useful arts. It did so before the AIA. And Congress did so again in the AIA, further overhauling the patent system. The relevant balance thus has been legislatively updated and refined in enactments that *Ariosa* does not purport to address.

In any event, there is good reason to limit published patent applications to claimed subject matter in unpublished provisional applications. It can be extraordinarily complex to determine who is “another” for purposes of pre-AIA §102(e)(1), and whether subject matter is “owned by the same person or subject to an obligation of assignment to the same person” under pre-AIA §103(c). See, e.g., *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986) (complexly explaining how you determine “another”). A published patent application that qualifies as potential pre-AIA §102(e)(1) prior art requires an oath identifying the inventors of the inventions claimed in the application and the owner or assignee of the claims. While that will not itself resolve these complex issues, it certainly will help to simplify them. Given the informality of provisional applications, requiring a claim-based analysis brings much needed shape to the analysis.

¹¹ See, e.g., *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186 (Fed. Cir. 2008).

In sum, the general statements of the then-existing patent law set forth in 1926 in *Milburn* are not sweeping commands that override detailed statutes that did not exist at that time.

II. THE FEDERAL CIRCUIT'S DECISION IS CORRECT

Although the decision below is non-precedential and summary, the PTAB decision that it affirms was correctly reasoned.

Pre-AIA § 102(e)(1) states that applications *published* under pre-AIA § 122 may be prior art, but does not afford the same treatment for provisional applications under § 111(b). (Because the language of 102(a) and (d) is different today, the analysis may be different under current law. See pp. 12-14, *supra*.)

For a published application to obtain the benefit of an earlier provisional application, under pre-AIA law, the only viable provision is pre-AIA § 119(e)(1). Pre-AIA § 119(e)(1) states that an invention in a published patent application may obtain the benefit of the priority date of a § 111(b) application under certain circumstances. One requirement is that the provisional application must disclose “the invention” in satisfaction of pre-AIA § 112(a). “[T]he invention” that then receives the benefit of the provisional filing date is only the properly disclosed invention:

An application for patent filed under section 111(a) or section 363 of this title for an *invention* disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, *as to such inven-*

tion, as though filed on the date of the provisional application filed under section 111(b) * * * .

Pre-AIA § 119(e) (2006) (emphasis added).

The pre-AIA § 119(e)(1) provides that only the properly disclosed “invention” can receive priority back to the provisional filing date. Because the claims define the invention, that statutory text requires the prior-art analysis to consider whether the claims in the alleged pre-AIA § 102(e) document are properly supported in the provisional application. See *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002).

Ariosa has conceded that, in the context of a *patentee* claiming priority under pre-AIA § 119(e)(1), the “invention” refers to the claimed invention, and not an undefined disclosure in an application. *Ibid.*; see Pet. Reh’g En Banc in *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. 2016-2388 (Fed. Cir. Feb. 9, 2018), ECF 88 at 10. It would defy standard rules of statutory construction to give the single word “invention” in that provision different meanings for prior art and patent priority purposes. Ariosa nowhere explains how the text of pre-AIA § 119(e)(1) justifies such inconsistent usage.

CONCLUSION

For the reasons set forth above, the petition should be denied.

Respectfully submitted.

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